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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/123,253

07/27/98

HUTCHENS

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D-5639-C4

026271

IM52/0424

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EXAMINER

ALEXANDER, L

ART UNIT

PAPER NUMBER

1743

17

DATE MAILED:

04/24/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/123,253

Applicant(s)

HUTCHENS ET AL.

Examiner

Lyle A Alexander

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2000 and 06 February 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49-124 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 49-124 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 49-63, 86-115, 118-120 and 123-124 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 5,719,060. Although the conflicting claims are not identical, they are not patentably distinct from each other because both teach a probe and its associated method of use where a sample is bound to the probe and desorbed into a mass spectrometer by a laser.

Claims 49-124 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-46 of U.S. Patent No. 5,894,063. Although the conflicting claims are not identical, they are not patentably distinct from each other because both teach a probe with a non-metallic surface to which a sample is bound and desorbed into a mass spectrometer by a laser.

Claim Rejections - 35 USC § 102

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 49-55,57,59,62-71,73-74,76,78,81,84,86-93,95,97,100,101 and 105-113 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Breenen et al.

See the appropriate paragraph of paper 9.

Applicants have added the limitations that a macromolecule is desorbed and a single energy source is used to desorb the analyte from the probe. In the absence of particularly defining what size range of molecules are being claimed, Breenen et al. has been properly read on the instant claims. Additionally, Breenen et al. teach a single laser source to desorb the analyte which is indistinguishable from the instant claims.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 56,58,60-61,72,75,77,79-80,82-83,85,94,96,98-88,102-104 and 114-124 are rejected under 35 U.S.C. 103(a) as being unpatentable over Breenen et al.

See the appropriate paragraph of paper 9.

The new claims are also directed to materials of construction and would have been within the skill of the art for the same reasons stated in paper 9.

Response to Arguments

Applicant's arguments filed 7/13/00 have been fully considered but they are not persuasive.

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The obviousness-type double patenting rejection (ODP hereafter) over 08/068,896 has been vacated because the application has been abandoned. However, further search reveals that USP 5,894,063 is a continuation of the abandoned application and raises new ODP issues.

Applicants remarks and new amendments were persuasive in overcoming the rejections over Stuke and Zare et al.

Applicants state Breenen et al. fails to teach desorption of macromolecules. As stated above, in the absence of a specifically claimed size range, it is difficult to see any difference between the two. Even if a specific size range is claimed, in the absence of a showing of unexpected results, one would have expected the prior art to have performed equally well on any sized analytes, including what ever size range may be claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A Alexander whose telephone number is 703-308-3893. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 703-308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7718 for regular communications and 703-305-3599 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

April 23, 2001



LYLE A. ALEXANDER
PRIMARY EXAMINER